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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/845,643

04/30/2001

Srikar Rao

3965

23643

7590

10/25/2004

BARNES & THORNBURG
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INDIANAPOLIS, IN 46204

EXAMINER

WONG, STEVEN B

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,643

Applicant(s)

RAO, SRIKAR

Examiner

Steven Wong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 7, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Responsive to the decision by the Board of Appeals on June 22, 2004 and applicant's amendment filed June 28, 2004, this application has been reopened with the following new grounds of rejection:

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tate (5,305,999) in view of Tate (5,996,116). Regarding claims 6 and 7, Tate '999 discloses a golf tool comprising a ball marker (58) that is free of an appendage and has a solid face with an image thereon (note column 8, lines 31 and 32). Further, the ball marker (58) is made from iron or steel so that it is attracted to a magnetic slab (52). Tate '999 teaches for the tool to comprise a clip so that it may be attached to various items or serve as a money belt. However, Tate '999 does not specifically state that the device may be attached to a shoe.

Tate '116 reveals that Tate '999 is a golf tool that is intended to be attached to a belt, cap, shoe, pocket or golf bag. It would have been obvious to one of ordinary skill in the art to clip the tool of Tate '999 to a shoe in order to more easily retrieve the golf marker and also prominently display the tool.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tate (5,305,999) in view of Tate (5,996,116) and Kennedy (5,393,052). Regarding claim 9, Tate '999 provides a means (56) for removing the ball marker from the cavity.

Kennedy reveals a golf ball mark retaining device including a recess (16) and an indentation (60) for assisting in grasping the ball marker. It would have been obvious to one of

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ordinary skill in the art to replace the means (56) for removing the ball marker from the cavity as taught by Tate '999 with the indentation of Kennedy in order to provide an alternative means for assisting the user in removing the ball marker from the cavity.

Regarding claim 10, Tate '999 states that the ball marker indicia may be some ornamental design or logo. It would have been obvious to one of ordinary skill in the art to provide the indicia that is an indicator of origin in order to show a particular manufacturer.

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tate (5,305,999) in view of Tate (4,627,621). Tate '999 states that the clip may be used as a money clip by the golfer.

Tate '621 discloses a golf tool comprising a clip and a ball marker. Note the Abstract stating that the clip may be used as a money clip or alternatively as an attachment means to a belt, cap, shoe or golf bag. Thus, Tate '621 teaches the equivalence between a clip that is used as a money clip and a clip that is used for attaching the device to a belt, cap, shoe or golf bag. Also, Tate '621 teaches that attaching a golf ball marker tool to a belt, cap, shoe or golf bag is well known in the art.

It would have been obvious to one of ordinary skill in the art to attach the golf accessory of Tate '999 to a shoe in order to facilitate transportation of the tool by the golfer.

6. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tate (5,305,999) in view of Tate (4,627,621) and Kennedy (5,393,052). Regarding claim 9, Tate '999 provides a means (56) for removing the ball marker from the cavity.

It would have been obvious to one of ordinary skill in the art to replace the means (56) for removing the ball marker from the cavity as taught by Tate '999 with the indentation of

Kennedy in order to provide an alternative means for assisting the user in removing the ball marker from the cavity.


Regarding claim 10, Tate '999 states that the ball marker indicia may be some ornamental design or logo. It would have been obvious to one of ordinary skill in the art to provide the indicia that is an indicator of origin in order to show a particular manufacturer. z

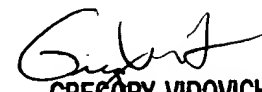
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 703-308-3135. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

SBW
October 8, 2004


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